

Application No. 10/541,121  
Request for Reconsideration

A. Timeline

In response to the non-final December 12, 2007 Office Action, Applicants filed an Amendment on May 12, 2008. In the Amendment, Applicants amended claim 1 and argued that the outstanding rejections should be withdrawn. Claim 1 was amended as follows:

Claim 1 (Currently Amended): A process for producing a veil comprising glass fibers and cellulose fibers ~~which comprises~~, comprising:  
a step of dispersing cellulose fibers and chopped glass fibers into a white water, ~~then a step of~~ forming a bed in a forming device by passage of the dispersion over a forming fabric through which the white water is drained off, the fibers being retained on ~~said the~~ fabric and ~~said the~~ dispersion comprising, during said passage, a cationic white water, and ~~then a performing a~~ heat treatment step in an oven device.

In response to the May 12, 2008 Amendment, a final Office Action was issued on June 23, 2008. In the June 23, 2008 Office Action, the rejections in the December 12, 2007 Office Action were withdrawn, and a new rejection over U.S. Patent No. 5,837,620 to Kajander ("Kajander") was made. The June 23, 2008 Office Action was made final because "Applicant's amendment necessitated the new ground(s) of rejection." See June 23, 2008 Office Action, page 4.

Applicants' representative discussed the finality of the June 23, 2008 Office Action with Examiner Halpern by telephone upon receipt of the June 23, 2008 Office Action. Examiner Halpern urged Applicants' representative to explain why the June 23, 2008 Office Action was improperly made final in Applicants' written response to the June 23, 2008 Office Action.

Applicants responded to the June 23, 2008 Office Action by filing an Amendment on October 23, 2008, including amendments and arguments distinguishing the claimed invention over Kajander, as well as written remarks regarding the improper finality of the June 23, 2008 Office Action as requested by the Examiner.

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On November 5, 2008, an Advisory Action was issued denying entry of the amendments in the October 23, 2008 Amendment. The Advisory Action did not address Applicants' remarks regarding the improper finality of the June 23, 2008 Office Action.

Subsequent to receipt of the Advisory Action, Applicants' representative again spoke with Examiner Halpern by telephone and explained why the November 5, 2008 Advisory Action should not have been issued. Examiner Halpern again urged Applicants' representative to provide written remarks explaining why the June 23, 2008 Office Action was improperly made final and, thus, the November 5, 2008 Advisory Action was improperly issued.

This paper constitutes such written response.

**B. The November 5, 2008 Advisory Action Should Not Have Issued**

MPEP §706.07 states "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period ...."

As discussed above, the June 23, 2008 Office Action included a new ground of rejection (over Kajander). According to MPEP §706.07, which is quoted above, the June 23, 2008 Office Action should not have been made final if: (a) Applicants' amendments to the claims did not necessitate the new rejection; and (b) the new rejection was not based on information submitted in an Information Disclosure Statement (IDS) during a particular time period.

Applicants' amendments to the claims did not necessitate the new rejection. As is evident from the excerpt above, the amendments to claim 1 in the May 12, 2008 Amendment were merely formal in nature. For example, the phrase "which comprises" was replaced with

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the phrase "comprising," and the phrase "a step of dispersing" is replaced with "dispersing." Also, the term "then" was deleted -- however, the sequence of steps remained implicit in the claim language (e.g., "by passage of the dispersion"). These amendments clearly did not affect the scope of the claims. It strains credulity to argue that the amendments to claim 1 in any way necessitated further search or consideration. Also, it is plain from the Examiner's Search Strategy and Results posted on PAIR on June 23, 2008 that the updated search strategy had nothing to do with the amendments to claim 1.

Kajander, which forms the basis of the rejection in the June 23, 2008 Office Action, was not cited in an IDS at all, but rather was cited by the Examiner. See June 23, 2008 Form PTO-892.

Accordingly: (a) Applicants' amendments to the claims did not necessitate the new rejection; and (b) the new rejection was not based on information submitted in an Information Disclosure Statement (IDS). The June 23, 2008 Office Action was improperly made final.

In view of the improper finality of the June 23, 2008 Office Action, the amendments in the October 23, 2008 Amendment should have been entered by right. See MPEP § 714; 37 C.F.R. § 1.112. Having so entered the amendments in the October 23, 2008 Amendment, the next paper issued by the Patent Office should have been a Notice of Allowance or a new Office Action, not an Advisory Action.

Requiring the Applicants to file a Request for Continued Examination (RCE) to proceed with prosecution with this application forces Applicants to incur significant expenses (and time) that would not be required, but for the Patent Office's error.

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In view of the foregoing, Applicants respectfully request that: (i) the amendments set forth in the October 23, 2008 Amendment be entered; and (ii) either a Notice of Allowance or new Office Action be issued upon consideration of the amendments and arguments set forth in the October 23, 2008 Amendment.

Respectfully submitted,

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